REMARKS

This is a Response to the Office Action mailed March 13, 2009, in which a three (3) month Shortened Statutory Period for Response has been set, due to expire June 13, 2009. Twenty-eight (28) claims, including eight (8) independent claims, were paid for in the application. Claims 19-46 have been amended. New claims 47 and 48 have been added. No new matter has been added to the application. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. Claims 19-48 are pending.

Substitute Specification

The substitute specification enclosed herein contains no new matter. Amendments to the specification are supported by Applicants' originally filed Figs. 8-17 which have now been cancelled as well as by the paragraph beginning on page 13, line 15 of the specification which is being deleted.

Objections

The drawings were objected to because of shading, stray markings and for containing text matter. Drawings - Figure 7 has been amended to eliminate shading and to make more legible. Figures 8-17 have been cancelled. One sheet of drawings is presented herewith for approval.

Rejections Under 35 U.S.C. § 101

Claims 19-46 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

In particular, the Office Action states that 'in order for a method to be considered a "process" under §101, a claimed process must either: (1) involve a particular machine, or (2) transform underlying subject matter (such as an article or materials).' The Office Action summarily concludes that claims 19-46 do not include the required tie or transformation, and concludes that those claims are not directed to statutory subject matter. The Office Action is

devoid of any explanation of why the Office considers the claims as not sufficiently tied to a particular machine or involve a sufficient transformation. Thus, the Office Action fails to set out a rationale sufficient to constitute a prima facie rejection. According to its own rules, as well as due process, the Office must provide a sufficiently detailed explanation of its reasoning to provide Applicants with notice and an opportunity to respond.

The Office Action states that 'storing in computer memory data is a nominal recitation and therefore given little weight.' Again, there is no explanation of why such is purportedly a "nominal recitation" and hence given little weight. Nor is there any explanation of what "little weight" means and how such fits in the statutory standards for patentability.

The "machine or transformation" test recited in the Office Action *only* applies to method or process claims. See In re Bilski; In re Comiskey. Thus, the Office has applied the wrong standard to claims 31-46. In particular, claims 31-42, 45 and 46 are directed to apparatus and claims 43 and 44 are directed to articles of manufacture, and thus are directed to clearly statutory subject matter under 35 U.S.C. 101.

With respect to claims 19-30, 47 and 48, the machine prong of the "machine or transformation" test asks whether the claimed process or method is sufficiently tied to a particular machine. Applicants respectfully assert that the method claims as originally filed were directed to a particular machine, and in particular required the storing of specific information in computer memory and the processing of such stored data. Such is in distinct contrast to the process or method claims in Bilski and in Comiskey, which were *not* limited to operation of a computer or other piece of hardware. In fact, the Federal Circuit avoided announcing what type or level of tie would be sufficient to satisfy the machine prong in Bilski nor Comiskey. The Office has not provided any explanation or rationale as to why the rejected method claims do not actually satisfy the machine prong of the "machine or transformation" test, but rather summarily concludes that those claims fail the test. According to its own rules, as well as due process, the Office must provide a sufficiently detailed explanation of its reasoning to provide Applicants with notice and an opportunity to respond.

The transformation prong of the "machine or transformation" test asks whether the claimed process or method involves a transformation of subject matter *or information that*

represents physical subject matter. See, In re Bilski 2007-1130 pages 25-26 discussing Abele ("This data clearly represented physical and tangible objects, namely the structure of bones, organs, and other bodily tissues. Thus, the transformation of that raw data into a particular visual depiction of a physical object on display was sufficient to render that more narrowly-claimed process patent-eligible."). Applicants respectfully assert that the method claims as originally filed were directed to a statutory transformation, and in particular transformed information representing utility usage of physical objects (*e.g.*, facilities, equipment, sites) and other statutory classes (*e.g.*, processes). The Office has not provided any explanation or rationale as to why the rejected method claims do not actually satisfy the transformation prong of the "machine or transformation" test, but rather summarily concludes that those claims fail the test. According to its own rules, as well as due process, the Office must provide a sufficiently detailed explanation of its reasoning to provide Applicants with notice and an opportunity to respond.

Additionally, the method claims have been amended to recite operation of a particular machine (*e.g.*, utility usage evaluation system), and to tie specific acts to specific structures (*e.g.*, computer-readable storage medium, processor) of the particular machine.

35 U.S.C. §102(b) Rejections

Claims 19-46 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Publication No. 2002/0178047 filed by Or et al. (hereinafter "Or").

Or describes an energy management and corrective method. The Or system works by monitoring energy usage at an energy consuming first facility and saving information regarding recording energy usage at that first facility. The Or system establishes a historical base-line energy usage at the first facility based on the saved information of energy usage. The system compares historical base-line energy usage to current energy usage at the first facility. The system determines excessive energy usage based on the comparison of historical base-line energy usage at the first facility to current energy usage at the first facility. The system then reports a recommended corrective action for excessive energy usage.

The Or system is very limited in the benchmark historical base-line energy usage available. Or describes how the energy management software system may perform benchmark

comparisons that show how the energy consumption and efficiency of a particular energy system in a facility compares to a benchmark comparable system and to historical energy usage for the system. Or, para. 0018.

The Or system only compares similar facilities. Or provides an example in terms of an HVAC system in a large apartment complex. Id. The HVAC system in the large apartment complex is compared with historical energy usage for the HVAC system. HVAC energy usage in one apartment building is also compared with HVAC energy usage in other similar apartment buildings. The only comparison given is between an HVAC system in one apartment building benchmarked against HVAC energy usage in other similar apartment buildings.

Or also describes measuring energy consumption by comparing the energy consumption of individual systems to energy consumption benchmarks. Or, para. 0029. These consumption benchmarks are all generated from similar facilities. Id.

This feature is a significant limitation to the Or system as in practice it is difficult to find two facilities that are similar. A significant disadvantage of the Or system is that it does not permit benchmarking against data collected from dissimilar facilities, or facilities that are not similar.

The present system described in Applicants' patent application states on page 15, lines 1-9 that reports are generated enabling benchmarking across different types of facilities. One example given is the comparison between a hospital ward and a hotel. This comparison of dissimilar facilities is made possible by the data entered by a user.

Referring to page 9, lines 20-26, a user enters facility or process details. The information includes general information on the facility or process such as the name, when it was built, what type of facility or process it is and so on. The user is able to enter further details such as the structure and utilization of the facility or process being benchmarked, the size of the facility or process, the materials from which a facility is constructed, and the frequency of use of the facility or process.

Referring to page 15, the utility usage evaluation system calculates an energy intensity from the equipment that is used to meet the facility type operating requirements. The

energy intensity is based on devices such as fume cupboards (*e.g.*, vent hoods) in laboratories and computers in computer laboratories or services. The energy intensity also allows for occasions when equipment is turned off as a normal part of the operation of the facility. One example is lights being turned off in a movie theatre.

The utility usage evaluation system further calculates a correcting factor that is time and use related for one or more facilities. The correcting factor correlates to the energy intensity of a facility or sub-facility. Once the utility usage evaluation applies these correcting factors to utility consumptions of facilities, facilities that are not similar to each other or dissimilar can be compared as if they were similar.

As amended, claim 19 recites, *inter alia,* "calculating by at least one processor of the utility usage evaluation system an energy intensity for one or more of the facilities, the energy intensity based at least partly on a timing and a frequency of use of equipment within the one or more facilities" "determining by at least one processor of the utility usage evaluation system respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities" and "applying by at least one processor of the utility usage evaluation system the correcting factors to the utility consumptions of the facilities."

Or does not teach or suggest calculating by at least one processor of the utility usage evaluation system an energy intensity for one or more of the facilities, the energy intensity based at least partly on a timing and a frequency of use of equipment within the one or more facilities; determining by at least one processor of the utility usage evaluation system respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities; and applying by at least one processor of the utility usage evaluation system the correcting factors to the utility consumptions of the facilities, as recited in claim 19.

As amended, claim 25 recites, *inter alia,* "calculating by at least one processor of the utility usage evaluation system an energy intensity for one or more of the processes, the energy intensity based at least partly on a timing and a frequency of use of equipment associated with the one or more processes;" "determining by at least one processor of the utility usage evaluation system respective correcting factors, the correcting factors correlating to the

calculated energy intensity or intensities;" and "applying by at least one processor of the utility usage evaluation system the correcting factors to the utility consumptions of the processes."

Or does not teach or suggest calculating by at least one processor of the utility usage evaluation system an energy intensity for one or more of the processes, the energy intensity based at least partly on a timing and a frequency of use of equipment associated with the one or more processes; determining by at least one processor of the utility usage evaluation system respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities; and applying by at least one processor of the utility usage evaluation system the correcting factors to the utility consumptions of the processes, as recited in claim 25.

As amended, claim 31 recites, *inter alia,* "a utility consumption calculator configured to calculate a utility consumption from each utility source for at least one facility, calculate an energy intensity for one or more of the facilities, the energy intensity based at least partly on a timing and a frequency of use of equipment within the one or more facilities, determine respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities, and to apply the correcting factors to the utility consumptions of the facilities;" and "a utility consumption comparer configured to compare the corrected utility consumption of one or more of the facilities with the utility consumption of respective benchmark standards automatically generated from dissimilar facilities."

Or does not teach or suggest a utility consumption calculator configured to calculate a utility consumption from each utility source for at least one facility, calculate an energy intensity for one or more of the facilities, the energy intensity based at least partly on a timing and a frequency of use of equipment within the one or more facilities, determine respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities, and to apply the correcting factors to the utility consumptions of the facilities;" "" and "a utility consumption comparer configured to compare the corrected utility consumption of one or more of the facilities with the utility consumption of respective benchmark standards automatically generated from dissimilar facilities, as recited by claim 31.

As amended, claim 37 recites, *inter alia,* "a utility consumption calculator configured to calculate the utility consumption from each utility source for at least one process,

calculate an energy intensity for one or more of the processes, the energy intensity based at least partly on a timing and a frequency of use of equipment associated with the one or more processes, determine respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities, and apply the correcting factors to the utility consumptions of the processes;" "" and "a utility consumption comparer configured to compare the corrected utility consumption of one or more of the processes with the utility consumption of respective benchmark standards automatically generated from dissimilar processes."

Or does not teach or suggest a utility consumption calculator configured to calculate the utility consumption from each utility source for at least one process, calculate an energy intensity for one or more of the processes, the energy intensity based at least partly on a timing and a frequency of use of equipment associated with the one or more processes, determine respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities, and apply the correcting factors to the utility consumptions of the processes; and "a utility consumption comparer configured to compare the corrected utility consumption of one or more of the processes with the utility consumption of respective benchmark standards automatically generated from dissimilar processes, as recited by claim 37.

As amended, claim 43 recites, *inter alia,* "calculating an energy intensity for one or more of the facilities, the energy intensity calculated based at least partly on a timing and a frequency of use of equipment within the one or more facilities;" "determining respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities;" and "applying the correcting factors to the utility consumptions of the facilities."

Or does not teach or suggest calculating an energy intensity for one or more of the facilities, the energy intensity calculated based at least partly on a timing and a frequency of use of equipment within the one or more facilities; determining respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities; and applying the correcting factors to the utility consumptions of the facilities, as recited by claim 43.

As amended, claim 44 recites, *inter alia,* "calculating by the at least one processor an energy intensity for one or more of the processes, the energy intensity based at least partly on the timing and frequency of use of equipment associated with the one or more processes;"

"determining by the at least one processor respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities;" and "applying by the at least one processor the correcting factors to the utility consumptions of the processes."

Or does not teach or suggest calculating by the at least one processor an energy intensity for one or more of the processes, the energy intensity based at least partly on the timing and frequency of use of equipment associated with the one or more processes; determining by the at least one processor respective correcting factors, the correcting factors correlating to the calculated energy intensity or intensities; and applying by the at least one processor the correcting factors to the utility consumptions of the processes, as recited by claim 44.

Hence the claims as amended define a useful system that applies corrections to utility consumptions in order to meaningfully benchmark dissimilar buildings. The prior art Or et al system only talks about comparing similar buildings. The present Applicants have developed a system that permits comparison of dissimilar buildings.

Conclusion

Applicants respectfully submit that the pending claims are in condition for allowance. Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. A number of clarifying amendments have also been made to the above claim set. Applicants do not acquiesce to each of the Examiner's rejections and to each of the Examiner's assertions regarding what the cited references show or teach, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter.

If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found. In light of the above amendments and remarks, Applicants respectfully submit that all

pending claims are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. The Examiner is encouraged to contact the undersigned by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, the Examiner is encouraged to contact the undersigned by telephone to expediently correct such informalities.

Respectfully submitted,

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FXA:sc

Enclosures:
Redlined Substitute Specification
Substitute Specification
1 Sheet of Drawings (Figure 7)

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